

REMARKS

Applicant is in receipt of the Office Action mailed November 28, 2003. Claim 23 has been amended. Claims 1-31 remain pending in the case. Reconsideration of the present case is earnestly requested in light of the following remarks.

Objections

The Summary of the Office Action indicated that there was an objection to the drawings, but the Office Action did not indicate the nature of the objection. Applicant does not know how the drawings are to be amended to overcome the objection.

The specification was amended to spell trademarked terms in all capitals.

The abstract was amended to remove occurrences of the unspecific term "may". The Office Action asserts that the first sentence of the abstract is not in narrative form. Applicant is unclear as to the nature of the objection to the abstract that "the first sentence of the abstract is not in narrative form". Applicant refers the Examiner to the numerous sample abstracts of MPEP 608.01(b), and notes that the MPEP recommends the form shown. Applicant notes that a replacement abstract was previously filed on March 28, 2001, and that the current amendments have been made with respect to that version.

Section 112 Rejections

Claim 23 was rejected under 35 U.S.C. 112, second paragraph as being indefinite. Claim 23 has been amended to more accurately describe the claimed invention. Removal of the 112 rejection of this claim is respectfully requested.

Section 102 Rejections

Claims 1-10, 12-17, and 19-31 were rejected under 35 U.S.C. 102(e) as being anticipated by Uczekaj et al. (US 5,920,718, "Uczekaj"). Applicant respectfully disagrees.

As the Examiner is certainly aware, anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim. *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984). The identical invention must be shown in as complete detail as is contained in the claims. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Claim 1 recites:

1. A computer-implemented method for programmatically generating a graphical program based on a state diagram, comprising:

receiving state diagram information, wherein the state diagram information specifies one or more states;

programmatically generating the graphical program in response to the state diagram information, wherein said programmatically generating comprises programmatically generating graphical source code corresponding to the specified one or more states.

The Office Action asserts that Uczekaj teaches all of the features and limitations of claim 1. Applicant respectfully disagrees. As described in the first paragraph of the summary (col. 2, lines 43-47) Uczekaj describes “a method and apparatus for automatically generating application program shell code for a predefined object-oriented application that is executable by an operating system”, and specifically does not disclose generation of a graphical program. While Uczekaj does disclose a graphical user interface for specifying objects, which are then used to generate the program shell code, no mention is made of generating a graphical program. In other words, Uczekaj’s method relates to object oriented programming, generation of program shell code (in a text-based programming language) for different operating systems, and a graphical user interface for performing the method, but not graphical programming as defined in the present application, and known to those skilled in the art, where a graphical program includes a plurality of interconnected nodes that visually indicate the functionality of the program. Applicant also notes that there is a substantial difference between generating

application program code and generating application program shell code, and submits that Uczekaj, as clearly described throughout the patent document, is specifically directed to the programmatic generation of text-based application shell code.

Thus, Uczekaj does not teach or suggest programmatically generating a graphical program in response to state diagram information, and so Applicant submits that claim 1, and claims dependent thereon, are patentably distinct over Uczekaj, and are thus allowable for at least the reasons provided above.

Independent claims 23, 25, 26, and 29 include similar limitations as claim 1, and so the arguments presented above apply with equal force to these claims. Thus, for at least the reasons provided above, Applicant submits that claims 23, 25, 26, and 29, and claims respectively dependent thereon, are patentably distinct over Uczekaj, and are thus allowable.

Removal of the 102 rejection of claims 1-10, 12-17, and 19-31 is respectfully requested.

Section 103 Rejections

Claims 11 and 18 were rejected under 35 U.S.C. 103(a) as being unpatentable over Uczekaj et al. (US 5,920,718, "Uczekaj"), further in view of Kodosky et al. (US 5,732,277, "Kodosky"). Applicant respectfully disagrees. Applicant also notes that since these claims depend from allowable independent claims, as argued above, claims 11 and 18 are similarly allowable as currently presented. Additional arguments are provided below.

To establish a prima facie obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974), MPEP 2143.03. Obviousness cannot be established by combining or modifying the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion or incentive to do so. In re Bond, 910 F. 2d 81, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990). As held by the U.S. Court of Appeals for the Federal Circuit in Ecolchem Inc. v. Southern California Edison Co., an obviousness claim that lacks evidence of a suggestion or motivation for one of skill in the art to

combine prior art references to produce the claimed invention is defective as hindsight analysis.

In addition, the showing of a suggestion, teaching, or motivation to combine prior teachings “must be clear and particular Broad conclusory statements regarding the teaching of multiple references, standing alone, are not ‘evidence’.” *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999). The art must fairly teach or suggest to one to make the specific combination as claimed. That one achieves an improved result by making such a combination is no more than hindsight without an initial suggestion to make the combination.

Furthermore, most if not all inventions arise from a combination of old elements. *See In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998). Thus, every element of a claimed invention may often be found in the prior art. *See id.* However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. *See id.*” *In re Werner Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000)

Claim 11 recites:

11. The method of claim 9,
wherein the placeholder graphical source code for each state comprises a case in a graphical case structure.

As argued above, Uczekaj fails to teach or suggest generation of a graphical program. Nor is there any teaching or suggestion in Uczekaj to include the limitation that *the placeholder graphical source code for each state comprises a case in a graphical case structure*, as admitted in the Office Action. Nor is there any teaching or suggestion in Kodosky to include the limitation of *programmatically generating the graphical program in response to the state diagram information, wherein said programmatically generating comprises programmatically generating graphical source code corresponding to the specified one or more states*. In fact, Kodosky specifically states that the state information is maintained internally for each virtual instrument (col. 37, lines 65-66). Moreover, as Kodosky specifically describes, the *data flow diagram is assembled in*

response to the user input utilizing icons which correspond to the respective executable functions, scheduling functions, and data types which are interconnected by arcs on the screen. In other words, the graphical program is generated manually, i.e., by the user, not programmatically. Additionally, while Kodosky describes execution states of graphical program nodes, these execution states are used to manage simultaneous execution of multiple virtual instruments, and do not refer to or represent the various cases of case structure.

Thus, for at least the reasons provided above, Applicant respectfully submits that neither Uczekaj nor Kodosky, either singly or in combination, teaches all of the limitations of claim 11, and so Applicant submits that claim 11 is non-obvious over Uczekaj in view of Kodosky, and is thus allowable.

Claim 18 recites:

18. The method of claim 1,
wherein the state diagram information further specifies an initially active state;
wherein said programmatically generating comprises programmatically generating graphical source code such that the graphical program begins execution in the initially active state.

Regarding claim 18, the arguments presented above with respect to manual vs. programmatic graphical program generation are applicable to claim 18. Additionally, as also argued above, Applicant notes that the state information referred to in the present application relates to the functionality of the program, and is not the same as that of Kodosky, in that Kodosky's state information is execution state information for the graphical program nodes themselves, and so is not usable to generate the graphical program of claim 18.

Thus, for at least the reasons provided above, Applicant respectfully submits that neither Uczekaj nor Kodosky, either singly or in combination, teaches all of the limitations of claim 18, and so Applicant submits that claim 18 is non-obvious over Uczekaj in view of Kodosky, and is thus allowable.

Applicant also asserts that numerous ones of the dependent claims recite further distinctions over the cited art. However, since the independent claims have been shown to be patentably distinct, a further discussion of the dependent claims is not necessary at this time.

Obviousness-Type Double Patenting Rejection

The Office Action provisionally rejected claims 1-10, 12-15, and 20-31 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of application No. 09/745023. Applicant respectfully traverses this double-patenting rejection at least with respect to some of the claims. However applicant respectfully requests that this double-patenting rejection be held in abeyance until the claims are otherwise indicated as allowable, at which time Applicant will consider the filing of a terminal disclaimer to obviate the rejection. Applicant notes that the filing of terminal disclaimer to obviate a rejection based on non-statutory type double patenting is not an admission of the propriety of the rejection. (See, e.g., MPEP 804.02).

CONCLUSION

Applicant submits the application is in condition for allowance, and an early notice to that effect is requested.

If any extensions of time (under 37 C.F.R. § 1.136) are necessary to prevent the above referenced application(s) from becoming abandoned, Applicant(s) hereby petition for such extensions. If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert & Goetzel PC Deposit Account No. 50-1505/5150-45900/JCH.

Also enclosed herewith are the following items:

- ☒ Return Receipt Postcard
- ☒ Notice of Change of Address

Respectfully submitted,



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